

Practitioner's Docket No. 019502.0007US1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Earl J. Votolato

Application No.: 10/010,158  
Filed: 11/13/2001  
For: Bag Slitting Apparatus

Group No.: 3724  
Examiner: T. Druan

Box Interference  
Commissioner for Patents  
Washington, D.C. 20231

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TRANSMITTAL OF APPEAL BRIEF  
(PATENT APPLICATION--37 C.F.R. § 1.192)

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1. Transmitted herewith, in triplicate, is the APPEAL BRIEF in this application, with respect to the Notice of Appeal filed on December 10, 2002.

2. STATUS OF APPLICANT

This application is on behalf of a small entity. A statement was already claimed.

3. FEE FOR FILING APPEAL BRIEF

Pursuant to 37 C.F.R. § 1.17(c), the fee for filing the Appeal Brief is \$160.00. This fee was paid with the filing of the Notice of Appeal on December 10, 2002. There are no outstanding fees.

**CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a) and 1.10\***

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4. EXTENSION OF TERM

The proceedings herein are for a patent application and the provisions of 37 C.F.R. § 1.136 apply.

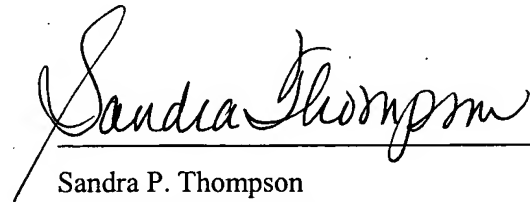
Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

5. FEE DEFICIENCY

If any additional extension and/or fee is required, and if any additional fee for claims is required, charge Deposit Account No. 502191.

Date:

2/10/2003



Sandra P. Thompson  
Registration No. 46264  
Rutan & Tucker LLP  
611 Anton Blvd., Suite 1400  
Costa Mesa, CA 92626  
714-641-5100  
Customer No. 34284

Practitioner's Docket No. 019502.0007US1

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: Votolato, Earl J.

Application No.: 10/010,158

Group No.: 3724

Filed: November 13, 2001

Examiner: Druan, Thomas J.

For: Bag Slitting Apparatus

Commissioner of Patents and Trademarks

Washington, D.C. 20231

ATTENTION: Board of Patent Appeals and Interferences

**APPELLANT'S BRIEF UNDER 37 CFR § 1.192**

This brief, which is transmitted in triplicate, follows the appellant's Notice of Appeal filed in this case on December 10, 2002. The fees required under 37 CFR §1.17(f) are included with this brief.

This brief contains the following items under the headings in the order here indicated:

**APPELLANT'S BRIEF UNDER 37 CFR § 1.192**

REAL PARTY IN INTEREST

RELATED APPEALS AND INTERFERENCES

STATUS OF CLAIMS

STATUS OF AMENDMENTS

SUMMARY OF INVENTION

ISSUES

## GROUPING OF CLAIMS

## ARGUMENT

ISSUE NO. 1 - §112 REJECTION OF CLAIMS 1-6

ISSUE NO. 2.- §102(b) REJECTION OF CLAIMS 1 & 6

ISSUE NO. 3 - §103(a) REJECTION OF CLAIMS 2-5

## CONCLUSION OF ARGUMENT

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## APPENDIX OF PENDING CLAIMS AS ORIGINALLY FILED

## REAL PARTY IN INTEREST

The real party in interest is the inventor, Earl J. Votolato

## RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences in this matter known to appellant.

## STATUS OF CLAIMS

There are 6 claims in this case. Claims 1-6 are pending and rejected. The claims on appeal are 1-6.

## STATUS OF AMENDMENTS

Amendments were filed on November 12, 2002 in response to the Final Office Action issued on September 11, 2002. An Advisory Action further rejecting the claims was mailed on December 4, 2002. A Notice of Appeal was filed on December 10, 2002.

## **SUMMARY OF INVENTION**

The invention is directed to a bag slitting apparatus for opening a sealed bag (See Figure 3, Number 10; Specification page 1, lines 12-19), and in particular to a bag slitting apparatus for opening a sealed bag (Figure 3, number 50) along an edge thereof and generally constructed as a spring-tensioned, resiliently connected, opposing arm device (Figure 3, Number 10; Figure 1, 2, and 4) wherein the inner surface of one arm thereof has a projecting blade (Figure 1 and 2, Number 30) for slitting a bag placed between the arms (Figure 2, Numbers 12 and 18; Specification page 4, lines 8-19) and wherein the outer surfaces of the arms are concavely contoured (See Figures 1 and 2, Number 31) for simultaneous opposing receipt of a finger and thumb of a user (See Figure 3, numbers 34 and 36).

Furthermore, a transverse, laterally-open concave groove (Figure 2, Number 32; Specification page 4, lines 9-14) is found on one of the inner surfaces (Figure 2, Number 22), opposite of the inner surface (Figure 2, Number 16) that holds/comprises the blade tip (Figure 2, Number 30), the concave groove designed to receive the blade tip and to keep a continuously moving bag edge through the bag slitting apparatus (Specification page 5, lines 5-13).

## **ISSUES**

1. Whether claims 1-6 should have been rejected under 35 U.S.C. §112 as being indefinite for failing to particularly point out and claim the subject matter. (Final Office Action 9/1//2002 (Paper No. 5), Page 2, Point 3)

2. Whether claims 1 and 6 should have been rejected under 35 U.S.C. §102(b) as being anticipated by Chen (US DES 276,786). (Final Office Action 9/1//2002 (Paper No. 5), Pages 2 and 3, Point 5)

3. Whether claims 2-5 should have been rejected under 35 U.S.C. §103(a) as being unpatentable over Chen (US DES 276,786) in view of Gilman (US 4,581,823). (Final Office Action 9/1//2002 (Paper No. 5), Pages 3 and 4, Point 6)

## **GROUPING OF CLAIMS**

Claims 1-6 stand or fall together.

## ARGUMENT

### ISSUE NO. 1 - §112 REJECTION OF CLAIMS 1-6

Claim 1 was rejected as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Applicant respectfully disagreed, but amended claim 1 to use the language that the Examiner recommended.

The phrase “resiliently connected” herein replaces the term “biased”. Although the Applicant maintains that the phrase “the first and second arms are biased” clearly means that there is an external force pushing the first and second arms away from one another, such that when someone presses on the first and second arms – forcing them together – and then releases the first and second arms, the first and second arms “spring” back to their original position., and that this “springing” back to the original position would not be possible without some external force on the first and second arms, the Applicant has herein amended claim 1. Based on the amendment to claim 1 in Paper No. 5, claim 1 is allowable as particularly pointing out and distinctly claiming the subject matter which Applicant regards as the invention, and thus, claims 2-6 are allowable by virtue of their dependency on independent claim 1.

### ISSUE NO. 2 - §102(b) REJECTION OF CLAIMS 1 & 6

Claims 1 and 6 were rejected under 35 USC §102(b) as being anticipated by Chen (US DES 276,786). The Applicant respectfully maintains his disagreement.

Claim 1 recites in part “A bag slitting apparatus for opening a sealed bag along an edge of said bag,...wherein the other of said inner surfaces has **a transverse laterally-open concave groove there across for receiving therein the blade tip and a continuously moving bag edge** there across for receiving therein the blade tip and a continuously moving bag edge...” (emphasis added). Claim 1 further recites that the first and second arms are “**resiliently connected**”. (emphasis added)

Chen teaches the ornamental design for a plastic bag opener, substantially as shown and described in the Design Patent at issue. The Chen design clearly shows **a convex surface** that is

directly opposite of the blade tip. Chen does not discuss or teach that a transverse laterally-open concave groove is or can be present in the ornamental design contemplated by Chen. Furthermore, as mentioned in earlier correspondence with the Examiner (Preliminary Amendment dated 11/13/2001), in the present application, the laterally-open groove permits continuous passage and slitting of a bag edge, whereas in Chen the second inner surface has a non-laterally-open walled hole for receiving the sharp projection – which appears to function as a punch – and consequently would not allow continuous movement for slitting a bag edge. Therefore, among other reasons, Chen does not disclose the claimed invention, which contains in part that there is a transverse laterally-open concave groove there across for receiving therein the blade tip. Further, after a fair review of the Chen Ornamental Design, one with ordinary skill in the art of opening and bag opening device design and assembly would not consider designing and using a transverse laterally-open concave groove there across for receiving therein the blade tip. Also, Chen clearly does not teach that the first or second arms are “resiliently connected”. The Applicant has taken the liberty of reproducing the Chen Ornamental Design, along with the apparatus contemplated in the present application, below. From the side-by-side comparison of the Chen Ornamental Design and the Votolato apparatus, it is clear that Chen does not anticipate the Votolato apparatus of the present application.



In addition, the Chen Ornamental Design does not teach all of the claimed elements of the present application. “Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration.” *W. L. Gore & Assocs. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983) (citing *Soundscriber Corp. v. United States*, 360 F.2d 954, 148 USPQ 298, 301 (Ct. Cl.), *adopted*, 149 USPQ 640 (Ct. Cl. 1966)) Further, the prior art reference must disclose each element of the claimed invention “**arranged as in the claim**”. *Lindermann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984)(citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)). The Chen Ornamental Design does not teach a transverse laterally-open concave groove there across for receiving therein the blade tip and the Chen Ornamental design certainly does not teach that the first and second arms are “resiliently connected”. Claim 1 is therefore allowable as not being anticipated by the Chen Ornamental Design. Further, the Chen Ornamental Design does not anticipate claim 6 of the present application by virtue of its dependency on claim 1.

### **ISSUE NO. 3 - §103(a) REJECTION OF CLAIMS 2-5**

Claims 2-5 are herein rejected under 35 USC §103(a) as being unpatentable over Chen (US DES 276,786) in view of Gilman (US 4,581,823). The Applicant respectfully maintains his disagreement.

The following is a quotation of MPEP 608.01 (n) page 600-70, column 2, paragraph 3:

“Examiners are reminded that a dependent claim is directed to a combination including everything recited in the base claim and what is recited in the dependent claim. **It is this combination that must be compared to the prior art, exactly as if it were presented as one independent claim.**” (Emphasis added).

In re Fritch reiterates MPEP § 608.01 (n) by stating that:

**“dependent claims are non-obvious if the independent claims**

from which they depend are non-obvious...” (972 F.2d 1260, 1266; 23 USPQ2d 1780, 1784 (Fed. Cir. 1992)). (Emphasis added).

Claims 2-5 of the present application are dependent on independent claim 1. Claim 1 is deemed non-obvious, and thus allowable, by the Examiner in Paper No. 3. Therefore, claims 2-5 must be allowable by virtue of their dependency on claim 1.

Aside from the above argument, claim 1 recites in part “A bag slitting apparatus for opening a sealed bag along an edge of said bag,...wherein the other of said inner surfaces has a transverse laterally-open concave groove there across for receiving therein the blade tip and a continuously moving bag edge there across for receiving therein the blade tip and a continuously moving bag edge...” (emphasis added). Claim 1 further recites that the first and second arms are “resiliently connected”. (emphasis added)

Chen teaches the ornamental design for a plastic bag opener, substantially as shown and described in the Design Patent at issue. The Chen Ornamental Design clearly shows a **convex surface** that is directly opposite of the blade tip. Chen does not discuss or teach that a transverse laterally-open concave groove is or can be present in the ornamental design contemplated by Chen. Therefore, among other reasons, the Chen Ornamental Design does not disclose the claimed invention, which contains in part that there is a transverse laterally-open concave groove there across for receiving therein the blade tip. Further, after a fair review of the Chen Ornamental Design, one with ordinary skill in the art of opening and bag opening device design and assembly would not consider designing and using a transverse laterally-open concave groove there across for receiving therein the blade tip. Also, the Chen Ornamental Design does not teach, suggest or motivate one of ordinary skill in the art to “resiliently connect” the first and second arms in order to improve the utility of the apparatus. As shown from the diagrams on the previous page, it is abundantly clear that the Chen Ornamental Design and the Votolato Apparatus from the present application are not similar at all in this respect, and the Chen Ornamental Design does not render the Votolato Apparatus in the present application as obvious. And based on this argument, among others, claim 1 of the present application is not obvious in view of Chen. Further, claims 2-5 are not obvious in view of Chen by virtue of their dependency on claim 1.

Gilman teaches a letter opener for cutting open an envelope comprising a channel-based blade holder having a pair of manually-movable arms and a cutting blade mounted on one of the arms. Gilman does not discuss or teach that a transverse laterally-open concave groove is or can be present in the contemplated embodiments of the Gilman patent. Therefore, among other reasons, Gilman does not disclose the claimed invention, which contains in part that there is a transverse laterally-open concave groove there across for receiving therein the blade tip. Further, after a fair review of Gilman, one with ordinary skill in the art of opening and bag opening device design and assembly would not consider designing and using a transverse laterally-open concave groove there across for receiving therein the blade tip. And based on this argument, among others, claim 1 of the present application is not obvious in view of Gilman. Further, claims 2-5 are not obvious in view of Gilman by virtue of their dependency on claim 1.

Finally, with regard to the present rejection, there is no motivation or suggestion to combine or modify the Chen Ornamental Design in view of Gilman, given that Gilman does not discuss or teach that a transverse laterally-open concave groove is or can be present in the contemplated embodiments of the Gilman patent. Gilman also does not discuss or teach that first and second arms or any part of the Gilman apparatus can be resiliently connected. Based on these arguments, among others including those discussed above, claim 1 is allowable as patentable over Chen in view of Gilman. Further, claims 2-5 are allowable as patentable over Chen in view of Gilman by virtue of their dependency on independent claim 1.

## **CONCLUSION OF ARGUMENT**

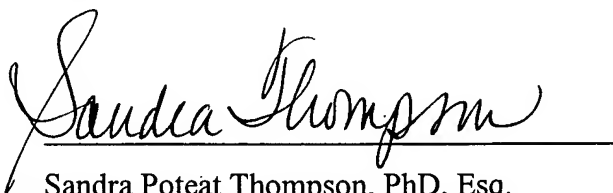
Claim 1 recites in part “A bag slitting apparatus for opening a sealed bag along an edge of said bag,...wherein the other of said inner surfaces has **a transverse laterally-open concave groove there across for receiving therein the blade tip and a continuously moving bag edge** there across for receiving therein the blade tip and a continuously moving bag edge...” (emphasis added). Claim 1 further recites that the first and second arms are “**resiliently connected**”. (emphasis added) Neither the Chen Ornamental Design nor the combination of the Chen Ornamental Design and the Gilman reference teach, disclose, suggest or motivate one of ordinary skill in the art to prepare a bag slitting apparatus with a transverse laterally-open

concave groove there across for receiving therein the blade tip and a continuously moving bag edge. Furthermore, neither the Chen Ornamental Design nor the combination of the Chen Ornamental Design and the Gilman reference teach, disclose, suggest or motivate one of ordinary skill in the art to prepare a bag slitting apparatus with resiliently connected first and second arms. Therefore, the present application is novel and not-obvious in view of the Chen Ornamental Design and the combination of the Chen Ornamental Design and the Gilman Reference.

Respectfully submitted,

Rutan & Tucker, LLP

Dated: February 10, 2003

A handwritten signature in cursive script, reading "Sandra Poteat Thompson", written over a horizontal line.

Sandra Poteat Thompson, PhD, Esq.  
Reg. No. 46,264  
Attorneys for Appellant(s)  
Post Office Box 1950  
Costa Mesa, CA 92628-1950  
Phone: 714-641-3468  
Fax: 714-546-9035

## **APPENDIX OF PENDING CLAIMS**

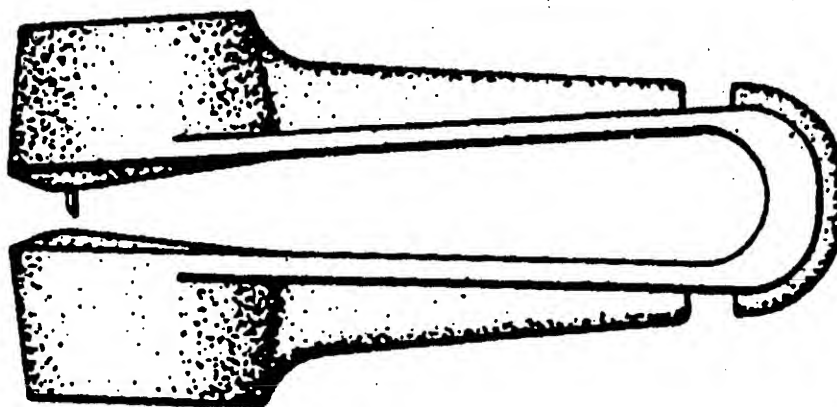
1. A bag slitting apparatus for opening a sealed bag along an edge of said bag, the apparatus comprising a first arm having a first outer surface and a first inner surface, a second arm having a second outer surface and a second inner surface, wherein said first and second arms are resiliently connected and in tensioned movable opposed relationship to each other such that the first and second inner surfaces are movably positionable against each other and wherein one of said inner surfaces is a bladed inner surface having projecting therefrom a bag cutting blade with a distal blade tip and wherein the other of said inner surfaces has a transverse laterally-open concave groove there across for receiving therein the blade tip and a continuously moving bag edge, and additionally where the first and second outer surfaces are concavely contoured for simultaneous opposing receipt of a finger and thumb of a user.
2. A bag slitting apparatus as claimed in Claim 1 wherein said apparatus is fabricated as a single piece of material.
3. A bag slitting apparatus as claimed in Claim 2 wherein the single piece of material is rigid plastic.
4. A bag slitting apparatus as claimed in Claim 1 wherein said apparatus except for the bag cutting blade is fabricated as a single piece of material.
5. A bag slitting apparatus as claimed in Claim 4 wherein the bag cutting blade is metal.
6. A bag slitting apparatus as claimed in Claim 1 wherein the blade tip receiver is a surface-disposed groove in alignment with the blade tip.

**APPENDIX OF PENDING CLAIMS AS ORIGINALLY FILED**

1. A bag slitting apparatus for opening a sealed bag along an edge of said bag, the apparatus comprising a first arm having a first outer surface and a first inner surface, a second arm having a second outer surface and a second inner surface, wherein said first and second arms are in tensioned movable opposed relationship to each other such that the first and second inner surfaces are movably positionable against each other and wherein one of said inner surfaces is a bladed inner surface having projecting therefrom a bag cutting blade with a distal blade tip and wherein the other of said inner surfaces has a blade tip receiver, and additionally where the first and second outer surfaces are concavely contoured for simultaneous opposing receipt of a finger and thumb of a user.
2. A bag slitting apparatus as claimed in Claim 1 wherein said apparatus is fabricated as a single piece of material.
3. A bag slitting apparatus as claimed in Claim 2 wherein the single piece of material is rigid plastic.
4. A bag slitting apparatus as claimed in Claim 1 wherein said apparatus except for the bag cutting blade is fabricated as a single piece of material.
5. A bag slitting apparatus as claimed in Claim 4 wherein the bag cutting blade is metal.
6. A bag slitting apparatus as claimed in Claim 1 wherein the blade tip receiver is a surface-disposed groove in alignment with the blade tip.

# Chen Ornamental Design (DES 276,786)

FIG. 1.



## Votolato Apparatus (Present Application)

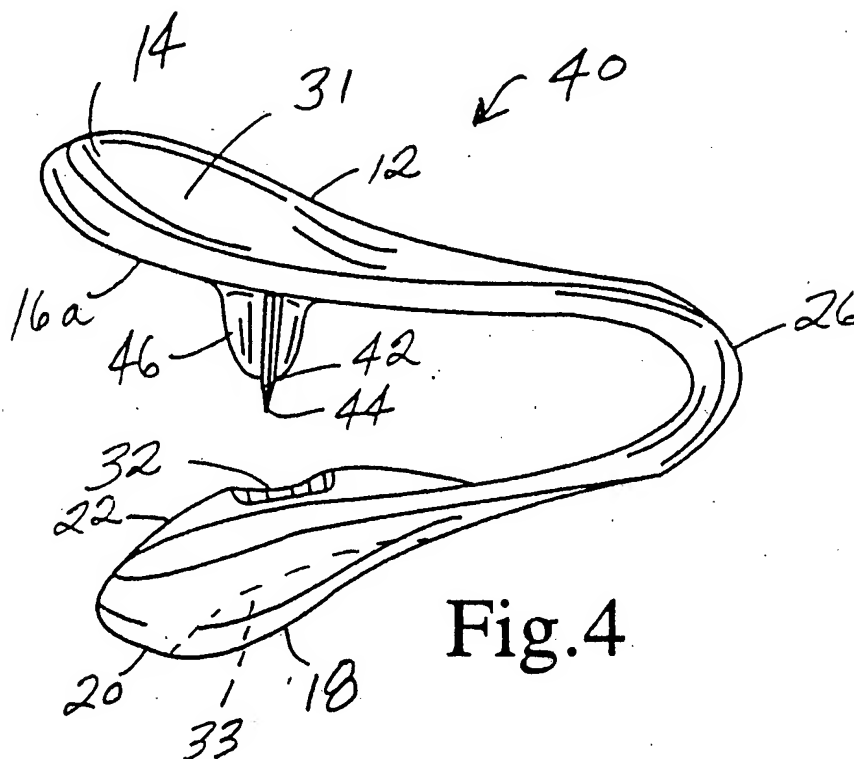


Fig.4